THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL A. TRAVIS

Appeal No. 95-1946
Application 07/525,405[1]

HEARD: June 5, 1996

Before HAIRSTON, CARDILLO and FLEMING, *Administrative Patent Judges*.

FLEMING, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 16, all of the claims present in the application.

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[1] Application for patent filed May 18, 1990.

The invention is directed to computer word processing systems and in particular, the invention is directed to a method and apparatus for remembering and correcting misspelled words. Appellant discloses on pages 3 and 4 of the specification that the preferred embodiment of the invention is part of a spell checking program. The program includes a file, labeled the "corrected before" file 12. The file contains a list of misspelled words and associated correctly spelled words. Appellant discloses on page 4 of the specification that Figure 1 is a block diagram which illustrates the processing units. Word processing document 10 contains a list of words. The dictionary file 14 contains a list of dictionary words.

As disclosed on pages 4 and 5 of the specification, find misspelled word unit 11 successively fetches words from the word processing document 10 and then reads the dictionary file 14 to determine if the word fetched is in the dictionary. If the fetched word is not in the dictionary, then it is assumed to be misspelled and a pointer is then passed to the check corrected before file unit 12. The check corrected before file unit 12 then reads the corrected before file 15 to determine if the file contains the misspelled word. If the misspelled word is in the corrected before file 15, the check corrected before file unit 12 sends a pointer to the misspelled word in the word processing document 10 and a pointer to the associated correctly spelled

word to the correct spelling unit 13. The correct spelling unit 13 then replaces the misspelled word in the word processing document 10 with the correctly spelled word to complete the correction.

If the word is not in the corrected before file 15, the correct spelling unit 13 prompts the user for the correct spelling and asks whether the correction should be stored in the corrected before file. As disclosed on page 6 of the specification, if the user indicates that the correction should be stored, then the correct spelling unit 13 stores the misspelled word and the correctly spelled word into the file. The correct spelling unit 13 corrects the misspelling in the word processing document 10 and fetches the next word.

The independent claims 1 and 4 are reproduced as follows:

1. A method in a computer system for checking the spelling of words in a document and correcting misspelled words, the system having a dictionary file containing a list of correctly spelled words, the method comprising the steps of:

(a) storing a list of misspelled words and associated correctly spelled words in a corrected before file;

(b) retrieving a word from the document;

(c) ascertaining whether the retrieved word is in the list of correctly spelled words of the dictionary file;

(d) if the retrieved word is in the list of correctly spelled words, then looping to step (b) to check the spelling of another word in the document;

(e) determining whether the retrieved word is in the corrected before file as a misspelled word;

(f) if the retrieved word is in the corrected before file as a misspelled word, automatically replacing the retrieved misspelled word in the document with the associated correctly spelled word from the corrected before file to effect the correction of the spelling and looping to step (b) to check the spelling of another word in the document;

(g) inputting a correctly spelled word from a user of the computer system;

(h) storing the retrieved misspelled word and the inputted correctly spelled word in the corrected before file; and

(i) replacing the retrieved misspelled word in the document with the inputted correctly spelled word to effect the correction of the spelling, and looping to step (b) to check the spelling of another word in the document.

4. A method in a computer system for correcting the spelling of words in a document, the system including a dictionary file containing correctly spelled words, the system also including a corrected before file containing misspelled words and associated correctly spelled words comprising the steps of:

retrieving a word from the document;

ascertaining whether the retrieved word is in the dictionary so as to determine if the retrieved word is correctly spelled;

if the retrieved word is not in the dictionary file, determining whether the retrieved word is in the corrected before file as a misspelled word; and

if the retrieved word is in the corrected before file, retrieving the associated correctly spelled word from the corrected before file and automatically replacing the retrieved word in the document with the associated correctly spelled word to effect the correction of the spelling.

The Examiner relies on the following references:

Westreich	4,650,349	Mar. 17, 1987
Sakai	4,818,131	Apr. 4, 1989
McRae et al. (McRae)	4,847,766	Jul. 11, 1989

The Examiner rejected claims 1 through 16 under 35 U.S.C. § 102 as being anticipated by Sakai. However, on pages 2 and 3 of the answer, the Examiner withdraws this rejection and thereby it is not before us on appeal. Claims 1 through 16 stand rejected under 35 U.S.C. § 102 as being anticipated by Westreich. Claims 1 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over McRae and Westreich.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for the respective details thereof.

OPINION

We will not sustain the rejection of claims 1 through 16 under 35 U.S.C. § 102.

It is axiomatic that anticipation of a claim under Section 102 can be found only if the prior art reference discloses every element of the claim. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986) and *Lindemann*

Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984).

On page 8 of the brief, Appellant agrees that the Examiner correctly states that Westreich discloses a list to store misspelled words and associate correctly spelled words and that the Westreich system has a dictionary. However on pages 8 and 9 of the brief, Appellant argues that Westreich does not teach the method steps of (1) retrieving a word from a document, (2) checking whether the retrieved word is in a dictionary, (3) if the retrieved word is not in the dictionary (i.e., misspelled), checking whether the retrieved word is in the Corrected Before File, and (4) if so replacing the retrieved word with the associated correctly spelled word as recited in each of Appellant's claims 1 through 16.

The Examiner responds to Appellant's arguments on pages 3 and 4 of the answer by arguing that Westreich teaches in col. 2, line 14 through column 3, line 4 and column 9, lines 39 through 51 that the Westreich system may be used to correct misspelled words. We agree with the Examiner that these portions of Westreich teach that the Westreich system may be used to correct misspelled words. However, this argument alone does not answer whether Westreich teaches the method steps and means as recited in Appellant's claims 1 through 16.

Westreich teaches in column 3 that replacement text and its unique Key entry are stored in memory adjacent to one another. As the operator makes an entry segment, characters bounded on either end by a "space" or "carriage return", into the word processor, such entry segment is compared with the pre-stored Key entries. If the examined entry segment identically compares with one of the pre-stored Key entries, the characters of the operator entry segment are immediately replaced by the pre-stored replacement text that is identifiably associated with that particular pre-stored Key entry. In column 3, lines 1-2, Westreich discloses that the system can be used for speed typing in which complex words or phrases can be quickly and correctly entered. The Examiner is correct that Westreich in column 3, lines 3-4, and column 9, lines 39-48, also discloses that the system may be used to correct misspelling by storing in memory common misspelling as the pre-stored Key entry and the correct spelling as the pre-stored replacement text. Thus, a segment entry, a common misspelled word, is corrected by the system because the system would compare the segment entry with the pre-stored Key entry and find the identical pre-stored Key entry and the associated pre-stored replacement text, whereby the pre-store replaced text, the correct spelling, replaces the segment entry, the misspelled word.

From these teaching, Westreich teaches the method step and means for retrieving an associated correctly spelled word from the corrected for file and replacing the retrieved word in the document with the retrieved associated correctly spelled word as recited in Appellant's claims 1 through 16. However, Westreich fails to teach the method steps or means for ascertaining whether the retrieved word is in the list of correctly spelled words of the dictionary file and if not determining whether the retrieved word is in the corrected before file as a misspelled word as recited in Appellant's claims 1 through 16. Therefore, we will not sustain the Examiner's rejection of claims 1 through 16 under 35 U.S.C. § 102.

Furthermore, we will not sustain the rejection of claims 1 through 16 under 35 U.S.C. § 103 as being unpatentable over McRae and Westreich.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the reasonable teachings or suggestions found in the prior art, or by a reasonable inference to the artisan contained in such teachings or suggestions. *See In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally

recognizable 'heart' of the invention." *Para-Ordnance Manufacturing v. SGS Importers International*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239, (Fed. Cir. 1995) *citing W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

Appellant argues in the brief on page 11 that the combination of McRae and Westreich does not teach or suggest of checking a dictionary and if the word is not in the dictionary checking a corrected before file. Appellant argues that the combination of McRae and Westreich would only suggest to operate the McRae's system for detecting and correcting commonly-confused words on the user input and to separately operate Westreich's system for automatic replacing of a word during data entry.

The Federal Circuit stated that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." ***In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84, (Fed. Cir. 1992), ***citing In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to find that McRae or Westreich suggests any desirability of checking a dictionary and if the word is not in the dictionary to check a corrected before file as recited in Appellant's claims 1 through 16. McRae teaches a word processor which checks each word upon entry with a list of

commonly confused words. If the entered word is found in the list, the word processor provides the typist with a display of the commonly-confused words and their definitions. As pointed out above, Westreich teaches a system for correcting spelling by an automatic replacement of text entered with an associated stored text string. However, neither reference suggests to those skilled in the art ascertaining whether the retrieved word from the document is in a dictionary file and if it is not, determining whether the retrieved word is in the corrected before file as a misspelled word. We agree that the reference could be modified to operate as Appellant's invention, but we fail to find that these references or the prior art suggest the desirability of making these modifications.

Therefore, we will not sustain the Examiner's rejection of claims 1 through 16 as being unpatentable under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

RAYMOND F. CARDILLO, JR.
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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